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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Miles R. Jackson

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EXAMINER

JOHNSON, CARLTON

ART UNIT

PAPER NUMBER

2436

NOTIFICATION DATE

DELIVERY MODE

05/13/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 10/688,815	Applicant(s) JACKSON, MILES R.	
	Examiner CARLTON V. JOHNSON	Art Unit 2436	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16, 20, 22 and 24-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16, 20, 22 and 24-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. This action is responding to application papers filed on 1-26-2009.
2. Claims **1 - 16, 20, 22, 24 - 28** are pending. Claim **20** has been amended. Claims **17 - 19, 21, 23, 29** have been cancelled. Claims **1, 20, 24, 26, 28** are independent. This application was filed on 10-17-2003.

Response to Arguments

3. Applicant's arguments have been fully considered but were not persuasive.
 - 3.1 There is no disclosure that a report is transmitted after each processed message. The claimed invention discloses: "transmit a report to a message originator after transmitting said message". The report is transmitted after processing of a message whether processing the first message, the last message, or any other message. There is no distinguishing which message is currently being processed. Applicant has stressed that the report of life history for a message which is equivalent to a report detailing the order of custody for a message does not contain information content. Examiner is unclear what is meant by this statement. The life history for a message contains information such as who opened it, whom it was forwarded from, who modified it, and the dates and times when reception, forwarding, and so forth occurred.

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Leonard discloses the embodiment whereby a central server is not used for the central storage of messages and the "life history of message". In this embodiment, the life history of a message must be within the viewer applet software since the viewer applet travels with the message itself. (Leonard col. 21, line 53 - col. 22, line 5: view applet is itself attached to encrypted electronic mail message and central server is eliminated entirely)

3.2 Applicant has stated in his remarks that the claimed invention states to embed the information concerning the order of custody within the message. The only disclosure concerning embedding concerns embedding the audit identifier within an attachment for attachment identification. The Brooks prior art discloses embedding (or attaching) an identifier to a message. (see Brooks col. 2, lines 31-34: email having the attachment identifier attached thereto)

3.3 There is no disclosure for a report identifier to identify a particular report within the claimed invention or the specification. There doesn't appear to be any claim limitation for identifying a particular report using a report identifier except in Applicant's remarks.

3.4 The Leonard prior art discloses that messages are actually forwarded or resent between systems. (see Leonard col. 10, line 67 - col. 11, line 3: a message to be forwarded or resent) Within the embodiment without a central server, a forwarding procedure a mail message involves an actual forwarding of the message.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims **1 - 10, 12 - 16, 24 - 27** are rejected under 35 U.S.C. 102 (e) as being anticipated by **Leonard et al.** (US Patent No. **6,721,784**).

Regarding Claim 1, Leonard discloses a communication device for communicating messages over a network comprising: at least one transceiver, configured to transmit and receive a message having a message identifier and a plurality of recipient identifiers wherein the plurality of recipient identifiers indicate an order of custody of the message by a plurality of different recipients (see Leonard col. 18, lines 45-50: life history of message: who received message, who opened it; to whom forwarded; who modified it; who printed it; and data and times actions occurred), and wherein each of the plurality of different recipients are unable to edit said plurality of recipient identifiers and the order of custody of the message. (see Leonard col. 19, lines 34-38: insert into the header flags to activate use of processing limitations; prevents editing by the recipient; controlled by special viewer)

Regarding Claim 2, Leonard discloses the communication device of claim 1, further

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comprising a memory, configured to store a message log associating a transmitted message with said message identifier and with said plurality of recipient identifiers. (see Leonard col. 7, line 66 - col. 8, line 4: storage for messages; col 8, lines 16-20: message transaction history; identification information)

Regarding Claim 3, Leonard discloses the communication device of claim 2, wherein: said transceiver is further configured to receive, from a recipient of said message, an update of said message log. (see Leonard col. 22, lines 14-18: installed viewer applet request information from central server each time message is handled; track all transactions; implies storage of current log information to track all message transactions)

Regarding Claim 4, Leonard discloses the communication device of claim 1, wherein said transceiver is further configured to transmit and receive amongst the plurality of different recipients via a plurality of transport layer mechanisms. (see Leonard col. 20, lines 9-13: transport layer mechanisms for communications between entities)

Regarding Claim 5, Leonard discloses the communication device of claim 1, wherein said transceiver is further configured to encapsulate said message in accordance with a protocol such that said message may be transmitted and received using said protocol. (see Leonard col. 4, lines 33-41: usage of existing protocols for message transfer; col. 7, lines 53-57: wrapper (encapsulate) message)

Regarding Claim 6, Leonard discloses the communication device of claim 1, wherein said transceiver is further configured to transmit a report to a message originator after transmitting said message wherein said message was previously received from said message originator. (see Leonard col. 8, lines 16-20: retrieve information (report) each time message is to be handled (each transactions))

Regarding Claim 7, Leonard discloses the communication device of claim 1, wherein said transceiver is further configured to transmit a report to a message originator after transmitting said message wherein said message was previously received from a message recipient. (see Leonard col. 8, lines 16-20: retrieve information (report) each time message is to be handled (each transactions))

Regarding Claim 8, Leonard discloses the communication device of claim 1, wherein said transceiver is further configured to receive, from a server, said message identifier and add said message identifier into said message prior to transmission of said message. (see Leonard col. 20, lines 50-56: sender and time (message identifier) coupled to message)

Regarding Claim 9, Leonard discloses the communication device of claim 1, wherein said transceiver is further configured to transmit a report to a server after transmitting said message wherein said message was previously received from said message originator. (see Leonard col. 22, lines 14-18: information (report) from the central server)

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each time message is handled)

Regarding Claim 10, Leonard discloses the communication device of claim 1, wherein said transceiver is further configured to transmit a report to a server after transmitting said message wherein said message was previously received from a message recipient. (see Leonard col. 22, lines 14-18: information (report) from the central server each time message is handled)

Regarding Claim 12, Leonard discloses the communication device of claim 11, wherein said audit identifier uniquely corresponds to the combination of said message identifier, said order of said plurality of recipient identifiers, and a message originator identifier. (see Leonard col. 20, lines 54-56; col. 22, lines 55-63: message processing information (audit identification information): who received message: recipient identification information; who send or originator of message identification)

Regarding Claim 13, Leonard discloses the communication device of claim 1, wherein said message comprises an encrypted message header that cannot be edited by recipients. (see Leonard col. 11, lines 23-29: encrypting the message; col. 10, lines 60-66; col. 15, lines 23-29: message attributes in a header; col. 19, lines 34-38: editing of message disabled (cannot be edited))

Regarding Claim 14, Leonard discloses the communication device of claim 13, wherein

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said encrypted message header further comprises: a message identifier field; a message originator field; and a recipient identifier field for containing said plurality of recipient identifiers. (see Leonard col. 10, lines 60-66; col. 15, lines 23-29: message header)

Regarding Claim 15, Leonard discloses the communications device of claim 14, wherein said encrypted message header further comprises a message expiration field. (see Leonard col. 10, lines 60-66: message attributes in a header; (expiration field); col. 9, lines 23-29: cause message to be erased at a time or date selected; expiration period)

Regarding Claim 16, Leonard discloses the communication device of claim 14, wherein said recipient identifier field further comprises a flag field for indicating a message originator preference setting. (see Leonard col. 10, lines 60-66: message attributes included in a header; col. 15, lines 23-29: message header control bits which selectively disable functions)

Regarding Claim 24, Leonard discloses a method of tracking information custody comprising: receiving a message by a first recipient electronic device, said message being sent from an originating electronic device; re-transmitting said message by said first recipient electronic device to at least a second recipient electronic device; and transmitting by said first recipient electronic device, a message log update, said

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message log update indicating that said message has been retransmitted to said at least said second recipient electronic device. (see Leonard col. 8, lines 29-33: track all persons to whom message has been forward (retransmitted))

Regarding Claim 25, Leonard discloses the method of claim 24, wherein said message log update comprises a message identifier, a recipient identifier for said first recipient, and a second recipient identifier for said second recipient. (see Leonard col. 8, lines 16-20: retrieve information each time message is processed; each transaction)

Regarding Claim 26, Leonard discloses the method of claims 24 further comprising: transmitting said message log update to a server. (see Leonard col. 22, lines 14-18: information (report) from the central server each time message is handled)

Regarding Claim 27, Leonard discloses the method of claim 26, further comprising: transmitting said message log update to said originating electronic device. (see Leonard col. 22, lines 14-18: information (report) from the central server each time message is handled)

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art

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are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims **11, 20, 22, 28** are rejected under 35 U.S.C. 103 (a) as being unpatentable over **Leonard** in view of **Brooks** (US Patent No. **7,209,953**).

Regarding Claim 11, Leonard discloses the communication device of claim 1, wherein said transceiver is further configured to receive, from a server, an audit identifier and add said audit identifier into a message attachment prior to transmission of said message. (see Leonard col. 20, lines 54-56; col. 22, lines 55-63: message processing information (audit identification information): who received message: recipient identification information; who send or originator of message identification)

Leonard does not specifically disclose an attachment and an attachment identifier. However, Brooks discloses wherein an attachment or an attachment identifier. (see Brooks col. 2, lines 28-31; col. 2, lines 41-44: attachment selection module generates an attachment identifier related to the file)

It would have been obvious to one of ordinary skill in the art to modify Leonard for a message attachment and identifier as taught by Brooks. One of ordinary skill in the art would have been motivated to employ the teachings of Brooks for a flexible, user friendly and efficient system and method to transmit file attachments of an email securely across a computer network. (see Brooks col. 2, lines 11-14)

Regarding Claim 20, Leonard discloses a server comprising:

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- a) a processor configured to assign and transmit an audit identifier to a message originator communications device via a network, said audit identifier for tracking resending and forwarding of said message, wherein said audit identifier uniquely corresponds to the combination of a message identifier, an order of recipient identifiers, and a message originator identifier; (see Leonard col. 20, lines 54-56; col. 22, lines 55-63: message processing information (audit identification information): who received message: recipient identification information; who send or originator of message identification) and
- b) a memory configured to store a plurality of said audit identifiers wherein each of said audit identifiers is associated with a message transmitted by said message originator communications device. (see Leonard col. 7, line 66 - col. 8, line 4: storage message information)

Leonard does not specifically disclose an attachment and an attachment identifier.

However, Brooks discloses wherein an attachment and an attachment identifier and

wherein the audit identifier is embedded into a message attachment. (see Brooks col.

2, lines 28-31; col. 2, lines 41-44: attachment selection module generates an

attachment identifier related to the file; col. 2, lines 31-34: email having the attachment identifier attached thereto)

It would have been obvious to one of ordinary skill in the art to modify Leonard for a message attachment and identifier as taught by Brooks. One of ordinary skill in the art would have been motivated to employ the teachings of Brooks for a flexible, user friendly and efficient system and method to transmit file attachments of an email

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securely across a computer network. (see Brooks col. 2, lines 11-14)

Regarding Claim 22, Leonard discloses the server of claim 21 wherein said audit identifier further comprises an identifier specific to said message. (see Leonard col. 20, lines 54-56; col. 22, lines 55-63: message processing information (audit identification information): who received message: recipient identification information; who send or originator of message identification)

Leonard does not specifically disclose an attachment and an attachment identifier.

However, Brooks discloses wherein an attachment or an attachment identifier. (see Brooks col. 2, lines 28-31; col. 2, lines 41-44: attachment selection module generates an attachment identifier related to the file)

It would have been obvious to one of ordinary skill in the art to modify Leonard for a message attachment and identifier as taught by Brooks. One of ordinary skill in the art would have been motivated to employ the teachings of Brooks for a flexible, user friendly and efficient system and method to transmit file attachments of an email securely across a computer network. (see Brooks col. 2, lines 11-14)

Regarding Claim 28, Leonard discloses a method of constructing a message by a communications device comprising:

- a) generating a message identifier; (see Leonard col. 20, lines 54-56: identify of sender and time of message are generated and coupled to message (message identifier))

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- b) adding said message identifier into a message header; (see Leonard col. 11, lines 23-29: encrypting the message; col. 10, lines 60-66; col. 15, lines 23-29: message attributes in a header; col 20, lines 54-56: sender identify coupled to message)
- b) adding a message originator identifier to said message header; (see Leonard col. 11, lines 23-29: encrypting the message; col. 10, lines 60-66; col. 15, lines 23-29: message attributes in a header; col 20, lines 54-56: sender identify coupled to message)
- c) adding at least one recipient identifier to said message header; (see Leonard col. 18, line 4: insert recipient's address in he header (recipient identifier) and
- d) receiving from a server an audit identifier, said audit-identifier useful for tracking resending or forwarding of a message attachment, wherein said audit identifier uniquely corresponds to the combination of a message identifier, an order of recipient identifiers, and a message originator identifier; (see Leonard col. 20, lines 54-56; col. 22, lines 55-63: message processing information (audit identification information): who received message: recipient identification information; who send or originator of message identification)
- e) embedding said audit identifier into said message; (see Leonard col. 20, lines 54-56; col. 22, lines 55-63: message processing information (audit identification information): who received message: recipient identification information; who send or originator of message identification)
- f) encrypting said message; (see Leonard col. 11, lines 23-29: encrypting the

message; attachment is part of message)

g) encrypting said message header. (see Leonard col. 11, lines 23-29: encrypting the message)

Leonard does not specifically disclose an attachment and an attachment identifier. However, Brooks discloses wherein an attachment or an attachment identifier. (see Brooks col. 2, lines 28-31; col. 2, lines 41-44: attachment selection module generates an attachment identifier related to the file)

It would have been obvious to one of ordinary skill in the art to modify Leonard to for message attachment and identifier as taught by Brooks. One of ordinary skill in the art would have been motivated to employ the teachings of Brooks in order for a flexible, user friendly and efficient system and method to transmit file attachments of an email securely across a computer network. (see Brooks col. 2, lines 11-14)

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlton V. Johnson whose telephone number is 571-270-1032. The examiner can normally be reached on Monday thru Friday , 8:00 - 5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Moazzami can be reached on 571-272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nasser G Moazzami/
Supervisory Patent Examiner, Art Unit 2436

Carlton V. Johnson
Examiner
Art Unit 2436

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